

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Mailed: 5/7/04

Opposition No. 91156321

The Chamber of Commerce of the
United States of America

v.

United States Hispanic Chamber
Of Commerce Foundation

Linda Skoro, Interlocutory Attorney

This case now comes up on several matters: (1) plaintiff's motion for defendant to surrender Registration No. 2,777,830, filed December 4, 2003; (2) plaintiff's motion to consolidate this proceeding with Opp. No. 91156340 and (3) plaintiff's motion to reset dates to include a counterclaim.

Background

It will be helpful to provide some background, or clarify the errors, that have led us to this point.

Applicant has two applications that plaintiff seeks to oppose: 78081731¹ ('731) and 78087678² ('678). The '731

¹ Filed August 29, 2003, for a design mark that includes the disclaimed words: "United States Hispanic Chamber of Commerce Foundation"; for "Providing educational and professional development classes, seminars, workshops, conferences, and camps to promote leadership and foster development of entrepreneurship

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application was published for opposition in the July 16, 2002 Official Gazette; the '678 application was published for opposition in the October 15, 2002 Official Gazette. Opposer was granted extensions of time to oppose both applications; the '678 filing period was extended to April 14, 2003 and the '731 filing period was extended to May 14, 2003. Opposer filed a notice of opposition against the '731 application on April 11, 2003. Opposition Number 91156321 was instituted against the '731 application on May 15, 2003. On May 7, 2003 opposer filed a notice of opposition against the '678 application and Opposition Number 91156340 was instituted against the '678 application on May 16, 2003. On May 14, 2003, a duplicate copy of the notice of opposition in Opposition No. 91156321 was received by the Board and instituted on June 23, 2003, under proceeding number 91156775. On August 26, 2003 the Board became aware of the duplicate opposition and dismissed the later-instituted proceeding, 91156775, as a nullity.

and business acumen among youth" in International Class 41, alleging a date of first use of May, 2001 and a date of first use in commerce of June, 2001.

² Filed October 10, 2001, for a slightly different design mark that includes the words: "H United States Hispanic Chamber of Commerce"; with "Chamber of Commerce" disclaimed and claim under § 2(f) as to "United States Hispanic Chamber of Commerce"; for "Chamber of commerce services, namely promoting business by and among Hispanic businesses and corporate America while fostering procuremen and economic development opportunities as well as commercial and financial relations by and among Hispanic businesses with the general business community" in International Class 35, alleging a date of first use and first use in commerce of 1999.

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However, when the termination was processed, the underlying application, 78081731, was inadvertently forwarded to registration. In that the application was still the subject of the prior instituted opposition, 91156321, the resulting registration, U.S. Reg. No. 2,777,830 was inadvertently issued.

Therefore, the issuance of a certificate of registration to applicant on October 28, 2003, was inadvertent and should be ignored by the parties, and opposition number 91156321 will continue apace.³

The file for the involved application, Serial No. 78081731, will be forwarded to the Office of the Assistant Commissioner for Trademarks, which will contact applicant to request return of the registration certificate.

Consolidation

Opposer has requested a consolidation of this proceeding with Opposition No. 91156340, which is the subject of a motion to dismiss for lack of jurisdiction. In that the motion to dismiss in that proceeding is being granted, and the proceeding is being dismissed as a nullity, the motion to consolidate is rendered moot.

³ In light of the fact that the registration was issued inadvertently and will be returned, that portion of opposer's December 4, 2003 motion requiring surrender is hereby denied as moot.

Reset Dates

In applicant's answer to the notice of opposition, filed June 26, 2003, applicant set forth a compulsory counterclaim seeking cancellation of four identified registrations owned by opposer. In light of this, a new trial schedule is required. Proceedings are hereby resumed and opposer has **THIRTY DAYS** from the mailing date of this order to file its answer to the counterclaim. The remaining dates are reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE: 6/20/2004

Thirty-day testimony period for
plaintiff in the opposition to close: 9/18/2004

Thirty-day testimony period for defendant in the opposition
and as plaintiff in the counterclaim to close: 11/17/2004

Thirty-day testimony period for defendant in the counterclaim
and its rebuttal testimony as plaintiff in the
opposition to close: 1/16/2005

Fifteen-day rebuttal testimony period for plaintiff in the
counterclaim to close: 3/2/2005

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due: 5/1/2005

Brief for defendant in the opposition and as
plaintiff in the counterclaim shall be due: 5/31/2005

Brief for defendant in the counterclaim and its reply

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brief (if any) as plaintiff in the opposition
shall be due:

6/30/2005

Reply brief (if any) for plaintiff in the
counterclaim shall be due:

7/15/2005

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